

### REMARKS

The Applicants respectfully submit this Amendment And Request for Reconsideration in response to the Office Action mailed on 30 November 2005. Applicants respectfully request entry of this Amendment and reconsideration of the application as amended.

The application was originally filed with claims 1-26. This Amendment amends claims 1, 8, 12, 18, and 23-26; no claims have been added or canceled. The application will therefore include claims 1-26 as amended for further consideration.

As required by 35 U.S.C. § 132, no new matter has been added. The amendments made to the claims and the new claims are fully supported by the original application.

*In the Office Action mailed on 30 November 2005, the Examiner rejected claims of the present application under 35 U.S.C. § 103(a) based on US Patent Application Publication US2005/0037755 A1 (Hind et al.) and other references including US Patent Application Publication US2004/0203610 A1 (Deeds). In response, the Applicants respectfully disagree and submit that all claims as amended are allowable over the prior art of record for at least the following reasons.*

For a proper rejection of claims under 35 U.S.C. § 103(a), the prior art in combination must teach or suggest each and every limitation of the claims. In the present case, the prior art fails to teach or suggest each and every limitation of the claims.

As provided herein, representative claim 1 has been amended as follows:

1. In a mobile communication device, a method of delivering an e-mail message through a wireless communication network comprising the acts of:

receiving, through a user interface of the mobile communication device, e-mail message information corresponding to a new e-mail message to be delivered through the wireless communication network;

identifying, by the mobile communication device, whether a data communication service for communicating e-mail messages is made available to the mobile communication device by the wireless communication network;

after receiving the e-mail message information and identifying whether the data communication service is made available by the wireless communication network:

causing, by the mobile communication device, the e-mail message information to be sent via the data communication service of the wireless communication network based on the data communication service being made available by the wireless communication network as identified by the mobile communication device; and

otherwise causing, by the mobile communication device, the e-mail message information to be sent in a short message service (SMS) message through the wireless communication network via an SMS-to-Email service based on the data communication service being made unavailable in the wireless communication network as identified by the mobile communication device.

In the present case, the prior art fails to teach or suggest the limitations that the *mobile communication device itself identifies whether the data communication service (e.g. a packet data service) is made available by the wireless communication network, and that the mobile communication device causes the e-mail message information to be sent in an SMS message via an SMS-to-Email service based on such identification that the data communication service is made unavailable.* This may be performed by a mobile communication device which automatically formats the e-mail information in an SMS format compatible with the SMS-to-Email service.

The prior art alone or in combination fails to teach or suggest such limitations. In Hind, a mobile communication device operates to select or prioritize wireless networks that make a data communication service available over networks that fail to make the data communication service available. However, Hind fails to teach or suggest how any e-mail messages could or would be sent from the mobile communication device if a selected network fails to make the data communication service available. In Deeds, a terminal is provided so that an end user may utilize an SMS-to-Email service to send messages from the terminal. However, there is no teaching or suggestion that e-mail message information would be sent by the terminal via the SMS-to-Email service in response to the terminal identifying that a data communication service (e.g. a packet data service) is made unavailable in the wireless network.

Further, in combining the teachings of the references under 35 U.S.C. § 103(a), the Examiner states that the purpose of the combination would be for “allowing mobile stations to communicate with e-mail format message within voice-only networks, and consequently providing convenience for users.” The Applicant respectfully submits that the Examiner’s stated suggestion is not enough for a proper §103 rejection. There must be some adequate suggestion or motivation in the references themselves to combine the teachings. The Examiner’s stated suggestion merely employs improper hindsight reconstruction in combining the references in attempt to produce the invention as claimed.

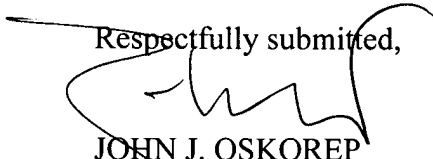
Further reasons for patentability and rejection deficiencies are clear to those ordinarily skilled in the art, requiring no elaboration at the present time.

The Applicant respectfully requests entry of the present amendment and reconsideration of claims 1-26 as amended in light of the arguments presented herein. The Applicant submits that the application is in a condition suitable for allowance.

Thank you. Please feel free to contact the undersigned if there are any questions or concerns regarding this submission.

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Respectfully submitted,

  
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